APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/040,934	12/31/2001	Keith Bussell	47661/SAH/S850	3791

			EXAMINER
23363	7590	01/09/2004	HINZE, LEO T

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ART UNIT	PAPER NUMBER
2854	

DATE MAILED: 01/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	**Application No.** 10/040,934		**Applicant(s)** BUSSELL, KEITH
	Examiner Leo T. Hinze	**Art Unit** 2854	

-- Th MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE **3** MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>22 September 2003</u>.

2a)☒ This action is **FINAL.**   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-9</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-9</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on <u>31 December 2001</u> is/are: a)☒ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

13)☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

    a) ☐ The translation of the foreign language provisional application has been received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)
2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3)☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
4)☐ Interview Summary (PTO-413) Paper No(s). _____.
5)☐ Notice of Informal Patent Application (PTO-152)
6)☐ Other: .

DETAILED ACTION

Claim Rejections - 35 USC § 102

1.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form

the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in
>
> public use or on sale in this country, more than one year prior to the date of application for patent in the United
>
> States.

2.   Claims 1 and 3-9 are rejected under 35 U.S.C. 102(b) as being anticipated by

Microsoft Word 2000, copyright 1983-1999.

Regarding claim 1, Microsoft Word teaches a method of printing postal indicia on a

custom sized envelope comprising: determining size of said custom sized envelope; selecting

a height of said custom sized envelope; selecting a width of said custom sized envelope (see

"Envelope Size" window of Figure 1 of this action); rendering a postal indicia in accordance

with the selected width and height of said custom sized envelope (see "Preview" picture of

envelope with postal indicia in "Envelope Options" window of Figure 1 of this action); and

printing the postal indicia on said custom sized envelope (see Figure 2 of this action).

Regarding claim 3, Microsoft Word also teaches assigning said custom envelope a

custom name.   The "Add to Document" button in the "Envelopes and Labels" window of

Figure 1 of this action allows the user to add the custom sized envelope to a document.   The

document may then be named and saved on the user's computer.
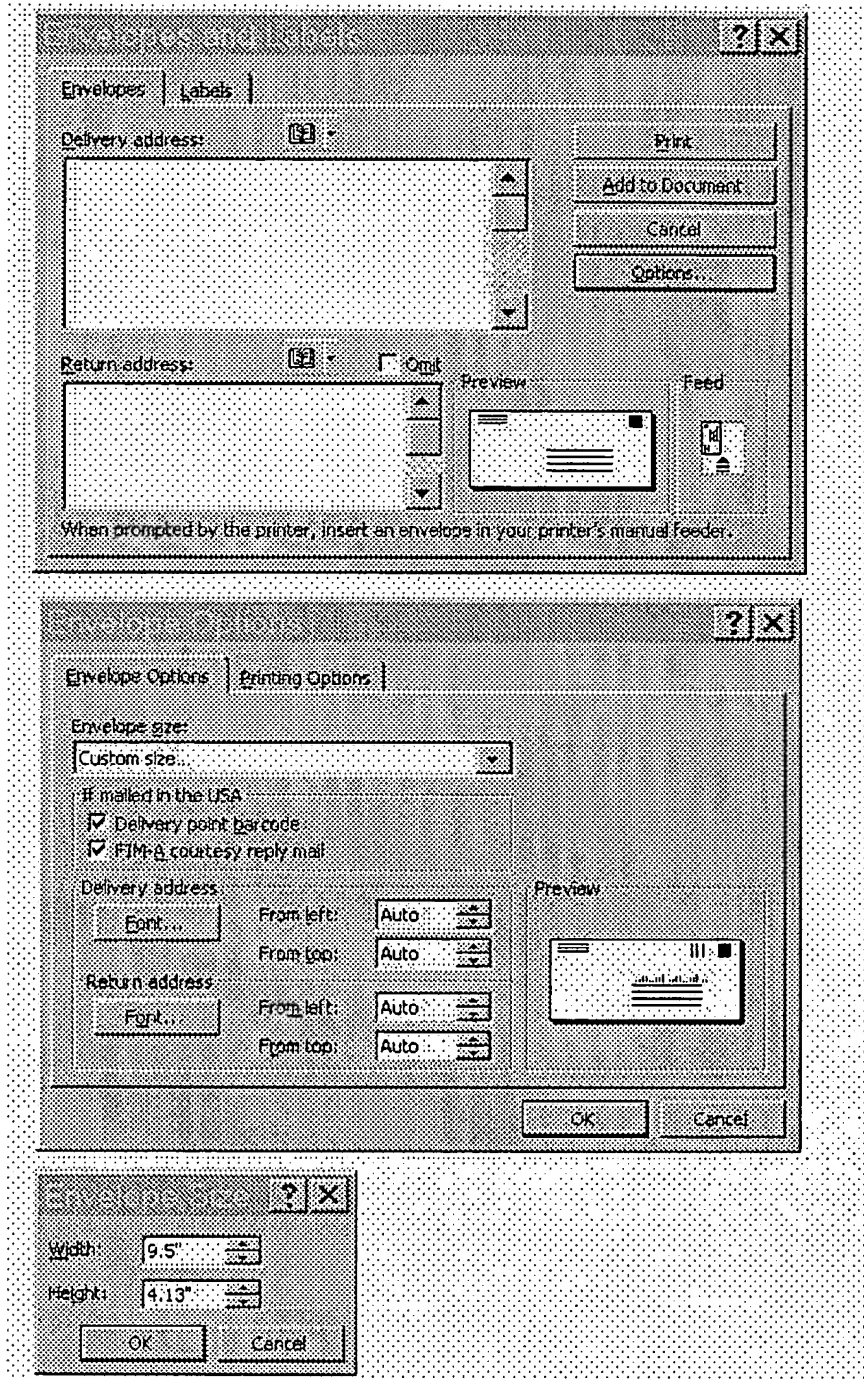
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Figure 1 - Microsoft Word Envelope Menus

Regarding claim 4, Microsoft Word also teaches wherein printing a postal indicia on the custom sized envelope comprises printing a two dimensional bar code onto the custom sized envelope (see "Preview" picture of envelope with postal indicia in "Envelope Options" window of Figure 1 of this action).

Print an attached envelope

If you've created an envelope and saved it with a document, you can print one or more copies of the attached envelope.

1. Open a document that has an attached envelope, and then click in the envelope.

2. Insert an envelope in the printer.

   To see how to place the envelope in the printer tray, click **Envelopes and Labels** on the **Tools** menu, click the **Envelopes** tab, and then insert the envelope in the printer as shown in the **Feed** box.

3. On the **File** menu, click **Print**.

4. In the **Pages** box under **Page range**, type 0 (zero).

Additional resources

Figure 2 - Microsoft Word Help - Envelope printing instructions

Include a POSTNET bar code or FIM-A code on an envelope

1. On the **Tools** menu, click **Envelopes and Labels**, and then click the **Envelopes** tab.

   Show me

2. If necessary, enter or edit the delivery and return addresses.

3. Click **Options**.

4. Click the **Envelope Options** tab.

5. To print a POSTNET bar code that contains U.S. ZIP Code information from the delivery address, select the **Delivery point barcode** check box.

   The POSTNET bar code will appear above the delivery address.

6. To print a FIM-A code that identifies the address side of a courtesy reply envelope, select the **FIM-A courtesy reply mail** check box.

   The FIM-A code will appear at the top of the envelope.

7. Select any other options you want.

   For Help on an option, click the question mark and then click the option.

8. In the **Envelopes and Labels** dialog box, do one of the following:

   • To print the envelope now, insert an envelope in the printer as shown in the **Feed** box, and then click **Print**.

   • To attach the envelope to the current document for later editing or printing, click **Add To Document**. When you're ready, you can print the attached envelope

Note The **Envelopes and Labels** command prints only FIM-A codes. If you need to print FIM-C codes, which are sometimes used for bulk mail, use the BARCODE field.

Additional resources

Figure 3 - Microsoft Word Help - Inserting POSTNET bar code or FIM-A code on an envelope.

Regarding claim 5, Microsoft Word also teaches wherein printing a postal indicia on the cusomt sized envelope comprises printing a FIM on the custom sized envelope (see Figure 3 of this action).

Regarding claim 6, Microsoft Word also teaches wherein printing said FIM on the custom sized envelope further comprises printing said FIM within a predefined distance of an edge of said custom sized envelope (see Figures 1 and 4 of this action, and compare the position of the FIM indicia on the envelopes in the "Preview" windows).
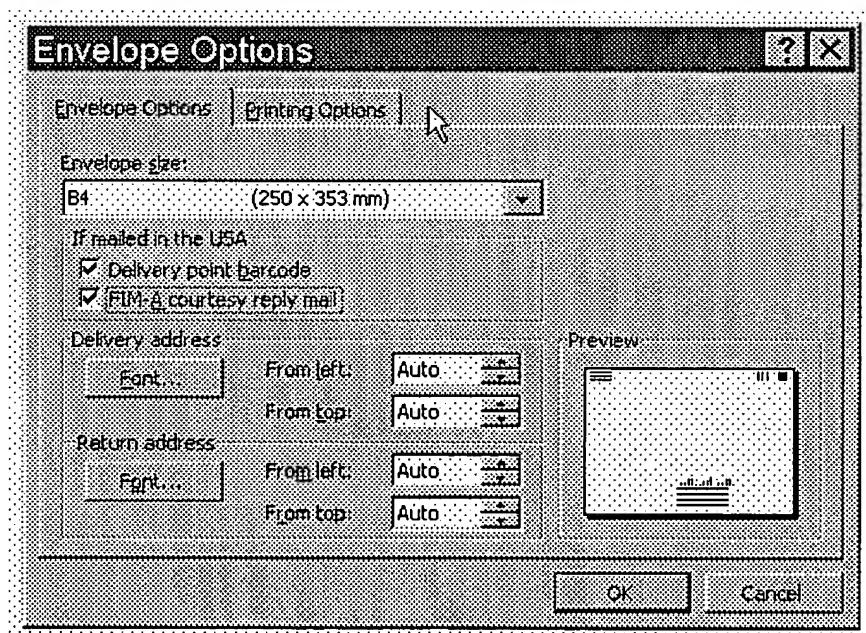

Figure 4 - Microsoft Word - FIM barcode position moves based on envelope size.

Regarding claim 7, Microsoft Word also teaches verifying the correct placement of the FIM on the custom sized envelope by visual inspection of the virtual envelope (see "Preview" box of the "Envelope Options" window in Figure 1 of this action).

Regarding claim 8, Microsoft Word also teaches storing the selected width and height and custom name of the custom sized envelope on a printer server database. The "Add to Document" button in the "Envelopes and Labels" window of Figure 1 of this action allows the user to add the custom sized envelope to the document. The document may then be named and saved on the user's computer.

Regarding claim 9, Microsoft Word also teaches wherein rendering a postal indicia in accordance with the selected width and height of the custom sized envelope comprises setting up a drawing surface ((see "Preview" box of the "Envelope Options" window in Figure 1 of this action) and shifting an origin of a virtualized sheet to position an image of the envelope in a printable area of the virtualized sheet (see Figures 1 and 4 of this action, and observe how the positions of the postal indicia and addresses on the envelopes are shifted in the "Preview" windows).

Applicant should note that these features are available in Microsoft Word and can be accessed by selecting the "Tools" menu, and then selecting the "Envelopes and Labels" option.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was

made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not

be negatived by the manner in which the invention was made.

4.   Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Microsoft Word

in view of DeBarber et al, US 5,152,122.

Microsoft Word teaches all that is claimed as discussed in the rejection of claim 1

above, except wherein determining the size of said envelope comprises determining the size

of said envelop by placing on a template.

DeBarber et al. teach a method of working with custom sized envelopes, including

inserting the envelope onto a template (52, Fig. 1), to determine the size of the envelope, and

also to determine if the envelope is between the smallest and largest sizes that can be used, in

order to eliminate trial and error of determine if the envelope is appropriately sized for the

machine (col. 3, lines 28-38).

It would have been obvious to one having ordinary skill in the art at the time the

invention was made to modify the printing method of Microsoft Word to include a template

for determining the size of the envelope, because DeBarber et al. teach that using a template

eliminates trial and error determinations of the appropriateness of the envelope size, and one

having ordinary skill in the art would recognize this as advantageous for saving time.

Response to Arguments

5.   Applicant's arguments with respect to claims 1-9 have been considered but are moot in

view of the new ground(s) of rejection.

Conclusion

6.   The prior art made of record and not relied upon is considered pertinent to applicant's

disclosure.   Feinstein, et al., US 6,342,899, Kramer, US 6,282,524, and Whitehouse, US

5,319,562 each teach postal indicia printing methods having obvious similarities to the instant

application.

7.   Applicant's amendment necessitated the new ground(s) of rejection presented in this

Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

MONTHS of the mailing date of this final action and the advisory action is not mailed until

after the end of the THREE-MONTH shortened statutory period, then the shortened statutory

period will expire on the date the advisory action is mailed, and any extension fee pursuant to

37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the date of
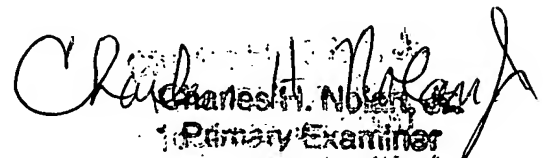
this final action.

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Leo T. Hinze whose telephone number is (703) 305-3339.

The examiner can normally be reached on M-F 8:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Hirshfeld can be reached on (703) 305-6619. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-0952.

Leo T. Hinze
Patent Examiner
AU 2854
15 December, 2003

Charles H. Nolan
Primary Examiner
Tech Center 2800